

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
BERT W. ELLIOTT	)	Group Art Unit: 3635
	)	
Serial No.: 09/515,928	)	Examiner: Ryan D. Kwiecinski
	)	
Filed: February 29, 2000	)	Confirmation No.: 1357
	)	
For: SHINGLE FOR OPTICALLY	)	Attorney Docket: 24673A
SIMULATING A SLATE ROOF	)	

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APPELLANT'S REVISED APPEAL BRIEF UNDER 37 C.F.R. § 41.37


Honorable Sir:

Responsive to the Notification of Non-Compliant Appeal Brief mailed March 14, 2008, please find enclosed a revised Appeal Brief.

If any fees are required pertaining to this response, Applicant requests that all necessary fees be charged to Deposit Account No. 50-0568.

Appellant accordingly requests that the Board of Patent Appeals and Interferences reverse the Examiner as to all rejections.

Respectfully submitted,

  
\_\_\_\_\_  
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### I. Real Party in Interest

The real party of interest is Owens Corning Intellectual Capital, LLC, the assignee of record, which is a corporation organized and existing by virtue of the laws of the State of Delaware, having its principal place of business in Toledo, Ohio.

### II. Related Appeals and Interferences

There are no other appeals or interferences that are known to Appellant, the Appellant's representative, or assignee which will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

### III. Status of Claims

Claims 17, 46-48, 53-58, 65-68 and 70 are finally rejected. Claims 1-16, 18-45, 49-52, 59-64, 69 and 71-73 are cancelled. Claims 17, 46-48, 53-58, 65-68 and 70 are appealed.

### IV. Status of Amendments

Appellant's submission July 10, 2007, subsequent to the final Office Action dated April 10, 2007, has been entered by the Examiner as stated in the Office Action dated September 19, 2007.

### V. Summary of Claimed Subject Matter

#### A. Independent Claim 17.

Appellant's specification states on page 1, at lines 12-19 that the roof covering of the present invention provides a weatherproof covering for a structure and an aesthetically pleasing architectural feature which enhances the overall appeal of the structure. Further, on page 1, at lines 19-24, the specification indicates that the roof covering of the invention includes laminated asphalt shingles that simulate the appearance of a natural slate roof.

As shown in FIG. 3, and described on page 7, in the paragraph beginning at line 22, the roof covering is formed by laying an arranged series of overlapping horizontal courses of laminated shingles on a roof deck. The laminated shingles are laid side-by-side and offset from shingles in adjacent courses.

In the embodiment shown in Figs. 1 and 2, and described on page 4 in the paragraph beginning at line 16, the roof covering includes laminated shingles consisting of an overlay member and an underlay member. As described on page 4 in the paragraph beginning at line 16, each of the overlay and underlay members are constructed of a suitable mat, permeated with an asphaltic material, and covered with granules.

As described in the paragraph beginning on page 4, at line 16 and the paragraph beginning on page 6, at line 20, the overlay member has front and rear surfaces. As described in the paragraph beginning on page 5, at line 3, the overlay member includes a headlap portion and a butt portion. The butt portion includes a plurality of tabs separated by cutouts as described in the paragraph beginning on page 5, at line 3. As described in the paragraph beginning on page 5, at line 14, each tab includes a layer of granules on the front surface forming a generally uniform color blend. As described in the paragraph beginning on page 5, at line 3, each cutout is narrow when compared to the width of the tabs.

As described in the paragraph on page 6, at line 20, the front surface of the underlay member is fixed to the rear surface of the overlay member. As described in the paragraph beginning on page 5, at line 14, each tab has a single color blend and the color blends of some of the tabs of each shingle have a different color blend from the color blend of other tabs.

As described in the paragraph beginning on page 6, at line 20, one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs, thereby defining a predominant tab color blend, with the frequency of the tabs of

the predominant color blend in the roof covering being sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof.

B. Independent Claim 55.

Appellant's specification states on page 1, at lines 12-19 that the roof covering of the present invention provides a weatherproof covering for a structure and an aesthetically pleasing architectural feature which enhances the overall appeal of the structure. Further, on page 1, at lines 19-24, the specification indicates that the roof covering of the invention includes laminated asphalt shingles that simulate the appearance of a natural slate roof.

As shown in FIG. 3, and described on page 7, in the paragraph beginning at line 22, the roof covering is formed by laying an arranged series of overlapping horizontal courses of laminated shingles on a roof deck. The laminated shingles are laid side-by-side and offset from shingles in adjacent courses.

In the embodiment shown in Figs. 1 and 2, and described on page 4 in the paragraph beginning at line 16, the roof covering includes laminated shingles consisting of an overlay member and an underlay member. As described on page 4 in the paragraph beginning at line 16, each of the overlay and underlay members are constructed of a suitable mat, permeated with an asphaltic material, and covered with granules.

As described in the paragraph beginning on page 4, at line 16 and the paragraph beginning on page 6, at line 20, the overlay member has front and rear surfaces. As described in the paragraph beginning on page 5, at line 3, the overlay member includes a headlap portion and a butt portion. The butt portion includes a plurality of tabs separated by cutouts as described in the paragraph beginning on page 5, at line 3. As described in the paragraph beginning on page 5, at line 14, each tab includes a layer of granules on the front surface forming a generally uniform color blend. As described in the paragraph beginning on page 5, at line 3, each cutout is narrow when compared to the width of the tabs.

As described in the paragraph on page 6, at line 20, the front surface of the underlay member is fixed to the rear surface of the overlay member. As described in the paragraph beginning on page 5, at line 14, each tab has a single color blend and the color blends of some of the tabs of each shingle have a different color blend from the color blend of other tabs.

As described in the paragraph beginning on page 6, at line 20, one of the color blends of the tabs is grey. The grey color blend occurs more frequently than any of the other color blends of the tabs, thereby defining a predominant tab color blend, with the frequency of the tabs of the grey color blend in the roof covering being sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof.

#### C. Independent Claim 67.

Appellant's specification states on page 1, at lines 12-19 that the roof covering of the present invention provides a weatherproof covering for a structure and an aesthetically pleasing architectural feature which enhances the overall appeal of the structure. Further, on page 1, at lines 19-24, the specification indicates that the roof covering of the invention includes laminated asphalt shingles that simulate the appearance of a natural slate roof.

As shown in FIG. 3, and described on page 7, in the paragraph beginning at line 22, the roof covering is formed by laying an arranged series of overlapping horizontal courses of laminated shingles on a roof deck. The laminated shingles are laid side-by-side and offset from shingles in adjacent courses.

In the embodiment shown in Figs. 1 and 2, and described on page 4 in the paragraph beginning at line 16, the roof covering includes laminated shingles consisting of an overlay member and an underlay member. As described on page 4 in the paragraph beginning at line 16, each of the overlay and underlay members are constructed of a suitable mat, permeated with an asphaltic material, and covered with granules.

As described in the paragraph beginning on page 4, at line 16 and the paragraph beginning on page 6, at line 20, the overlay member has front and rear surfaces. As described in the paragraph beginning on page 5, at line 3, the overlay member includes a headlap portion and a butt portion. The butt portion includes a plurality of tabs separated by cutouts as described in the paragraph beginning on page 5, at line 3. As described in the paragraph beginning on page 5, at line 14, each tab includes a layer of granules on the front surface forming a generally uniform color blend.

As described in the paragraph on page 6, at line 20, the front surface of the underlay member is fixed to the rear surface of the overlay member. As described in the paragraph beginning on page 5, at line 14, each tab has a single color blend and the color blends of some of the tabs of each shingle have a different color blend from the color blend of other tabs.

As described in the paragraph beginning on page 6, at line 20, one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs, thereby defining a predominant tab color blend, with the other color blends being accent colors that occur less frequently in the roof covering. The frequency of the tabs of the predominant color blend in the roof covering is sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof.

#### VI. Grounds of Rejection to be Reviewed on Appeal

Grounds of rejection are set forth in the Advisory Action dated July 19, 2007 and the final Office Action dated September 19, 2007, as:

A. Whether claims 67 and 68 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent 6,014,847 to Phillips (hereafter, “Phillips”) in view of U.S. Patent 1,843,370 to Overbury (hereafter, “Overbury”).

B. Whether claims 17, 46-48, 53-58, 65-68 and 70 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent 5,195,290 to Hulett (hereafter, “Hulett”) in view of U.S. Patent 1,843,370 to Overbury (hereafter, “Overbury”).

C. Whether claims 17, 46-48, 53-58, 65-68 and 70 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent 5,939,169 to Bondoc (hereafter, “Bondoc”) in view of U.S. Patent 1,843,370 to Overbury (hereafter, “Overbury”).

## VII. Argument

A. Rejection of claims 67 and 68 under 35 U.S.C. 103(a) over Phillips in view of Overbury.

The Examiner argued, on page 3 of the Final Office Action dated September 19, 2007, that it would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Phillips could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect.

The level of skill in the art of shingle design and process would be a person with at least a bachelor’s degree in mechanical or chemical engineering, or in materials science, and this person would have at least five years of experience in shingle design or shingle process.

As discussed at page 3, at line 3 of Appellant’s response dated July 20, 2001, the Phillips reference discloses a laminated shingle having a tabbed overlay attached to an underlay. The overlay has spaced apart tabs coated with a layer of colored granules. There are horizontal shadow lines at the top and bottom of the tabs, and a deeper horizontal shadow line along the top of the underlay, resulting in a staggered shadow line. As discussed at page 9, at the fourth paragraph of Appellant’s response dated July 27, 2006, the Phillips reference discloses a roof covering having a wood shake appearance. However, the Phillips reference fails to disclose the limitation that one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs to the extent that a predominant tab color blend is defined, with the other color blends being accent colors that occur less frequently in the roof covering,

and with the predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof.

The Overbury reference discloses a process of refurbishing asphalt shingles. Overbury discloses that initially, the original shingles are multi-tabbed shingles, having a surface layer of comminuted material, such as crushed slate.

There are a number of reasons why the skilled artisan would conclude that the Overbury reference fails to supply the missing limitation of the predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof.

1. Overbury's crushed slate covering does not provide the appearance of a natural slate roof. Although the Overbury reference discloses a shingle having a surface layer of crushed slate, using crushed slate as a surfacing material would give the roof an appearance of a single color, i.e., the color of the slate material used for the crushed slate layer. As explained in Appellant's response dated July 10, 2007, at page 9, in the last paragraph, the single uniform color of the comminuted material, even in the event the comminuted material is crushed slate, would not have the appearance of a natural slate roof. The single uniform color of Overbury would not have a predominant color blend with other color blends being accent colors that occur less frequently.

The term "natural slate roof" has the appearance of exposed portions of individual tiles partially overlaid by tiles of succeeding courses of tiles. As discussed in paragraph 10 of the declaration of the inventor Mr. Bert W. Elliott filed July 27, 2006, and the declaration of Mr. Donn R. Vermilion dated July 10, 2007, each of the exposed portions of tiles would have a single color, with at least about 60% of the tiles being of a predominant color, and typically significantly more than 60% of the tiles, such as for example 70-80%, with the remainder of the tiles being an accent color. As discussed in paragraph 9 of the declaration of the inventor Mr. Bert W. Elliott dated July 27, 2006, tabs of differing colors take on the appearance of an individual slate

tile, and a roof covering of such shingles gives the appearance of a plurality of adjacent slate roof tiles. As further stated by Mr. Elliott, the fact that the color blend of some of the tabs differs from the color blend of other tabs gives the appearance of a roof where some of the slate tiles differ in color from others of the slate tiles. As further discussed in paragraph 4 of the Declaration of Donn R. Vermillion dated July 10, 2007, one of the features of providing natural slate roofs is that different sources of natural slate are available in different regions of the country. Shipping costs for natural slate tiles are high because of the weight of the tiles, and therefore typically slate is obtained from local or regional sources. Different sources of natural slate have different colors. Commonly available natural slate colors are gray or green, and different natural slate colors such as red, purple or different shades of gray or green are more scarce. The realities of free market supply and demand commonly result in one slate color being less expensive than other slate colors. In any particular region the commonly available natural slate colors are less costly than the cost of the relatively scarce colors for that region. Accordingly, slate roofs typically have a predominant color, which is the least expensive color regionally available, with one or more additional colors interspersed to add variety and character to the roof covering.

Mr. Vermilion further stated that having a predominant color means that a natural slate roof has one color that occurs more frequently than the other colors in the roof. It also means that the more frequent color occurs sufficiently to be a prevalent color, and that the remaining colors are present for accent or variety. In fact, the prevalent color occurs with such frequency that the roof covering sometimes has an overall effect of just one color accented by the remaining colors.

The shingle disclosed in the Overbury reference in Fig. 6 shows that the leftmost tab is wider than any of the other tabs, and therefore the color of that tab would have more exposed area or coverage area when the shingles are installed as a roof covering. However, a simple analysis of Overbury's shingles, focusing on the width of each of the tabs of the shingle in Fig. 6, indicates that at best the most

predominant color, the leftmost tab in Fig. 6, would amount to about one-third of the surface area of the roof covering. This relatively low percentage would not be sufficient to make this one color a predominant color, and therefore the roof covering of this combination would not have an appearance of a natural slate roof. Further, as discussed in the July 10, 2007 declaration by Mr. Vermilion, the width of the leftmost tab is not so great that a person of ordinary skill in the art would expect the overall roof appearance to be that of a natural slate roof since there would not be a predominant color to the extent expected in a natural slate roof.

2. Overbury does not disclose a frequently occurring color blend. As discussed at page 10, at line 5 of Appellant's response dated July 10, 2007, the Overbury reference fails to disclose a frequently occurring color blend defining a predominant color that simulates a natural slate roof, with the remainder of the tiles being of an accent color. Rather, the Overbury reference discloses that the resurfacing material can be colored, and that the colors of the additional layer of surfacing material can be arranged so that each color is confined to a portion of the strip shingle which corresponds to one tab of the shingle. Further, Overbury discloses that the color of each tab is different from that of another tab. Appellant asserts that a natural slate roof has the appearance wherein one of the color blends occurs with enough frequency so as to define a predominant color, with other color blends occurring for accent. The predominant color, being sufficiently prevalent and accented by other color blends, simulates the appearance of a natural slate roof. As discussed in paragraph 9 of the declaration by Bert W. Elliott filed January 24, 2005, customers are willing to pay a premium price over standard shingles to achieve the appearance of a natural slate roof, particularly since the installed cost of genuine or natural slate roofs is extremely high. There is nothing contained in the Overbury reference that shows or suggests the claimed limitation of a frequently occurring color blend defining a predominant color that simulates a natural slate roof, with the remainder of the tiles being of an accent color.

3. Overbury's use of the term "now and then" fails to result in a predominant color. As discussed in Appellant's response dated July 10, 2007, at page 10, at the second paragraph, the Overbury reference discloses that each shingle "will have a solid color different from other tabs in the strip, although if desired two or more adjacent tabs may now and then be given the same color." [Emphasis added]. This is a teaching that the one color would occur more frequently than other colors. As discussed in paragraph 20 of the Declaration of the inventor Mr. Bert W. Elliott dated July 27, 2006, the term "now and then" would be interpreted by a person of ordinary skill as limiting the occurrence of multiple tabs of the same color in the same shingle to occasional occurrences, occurring seldomly. Mr. Elliott stated he would not expect the resulting roof covering to have a predominance of one color. Further, Mr. Elliott indicated that "now and then" would connote only infrequent deviations from the norm, and therefore there will be no predominant color for the resulting roof covering. Without a predominant color, the resulting roof covering would not have the appearance of a natural slate roof, and therefore the product would not be meeting the needs of the customers.

4. There is no suggestion to make the appearance of a natural slate roof. As discussed at page 10, at the final paragraph of Appellant's response dated July 10, 2007, there is no disclosure or suggestion in either reference directing anyone to increase the surface exposure of any one color to make the one color a predominant color to the extent that the roof covering has an appearance that simulates a natural slate roof.

5. There is no knowledge in the art suggesting the combination. Appellant asserts there is nothing in the knowledge generally possessed by one of ordinary skill in the art which would lead to modifying either of the references to provide one color of sufficient frequency or coverage area to simulate a natural slate roof.

6. Secondary considerations compel a finding of a lack of obviousness. In addition to the arguments set forth above and as discussed in paragraphs 9-16 of the

declaration of the inventor Bert W. Elliott dated January 18, 2005, the claimed invention also enjoys many secondary consideration benefits that support non-obviousness. Appellant's shingle product has satisfied a long felt need in the residential shingle market for a roof covering having the appearance of a conventional slate tile roof at a substantially less cost. In filling this long felt need of the residential shingle market, Appellant has enjoyed overwhelming commercial success exhibited through great demand by customers in the residential shingle market and also by rapidly growing sales of its shingle product. Additionally, the overwhelming need and positive response to Appellant's shingle product is further evidenced by Appellant's competitors copying their shingle product as soon as the product was released onto the market.

These claims of secondary considerations are fully supported by the declaration of Bert Elliott. Mr. Elliott was a Project Leader for Owens Corning (the assignee of the present patent application) and led the design of the claimed invention. Specifically, Mr. Elliott has over 16 years experience in the residential roofing market, having worked extensively in the areas of product development, production, and promotion of residential roofing products. Mr. Elliott has attested in his declaration that the shingle product of the claimed invention has satisfied a long felt need in the residential shingle market. Mr. Elliott has also provided overwhelming proof of the outstanding commercial success of the claimed shingle product, quoting first year sales, in 2003, in excess of \$3,000,000, which was realized with no extraordinary advertising expenditures.

Appellant asserts the commercial success of the shingle product of the claimed invention is commensurate with the scope of the claims. As one example, independent claim 17 includes the claim limitation wherein each tab has a single color blend, the color blends of some of the tabs of each shingle being a color blend different from the color blend of others of the tabs; and wherein one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs, thereby defining

a predominant tab color blend, with the frequency of the tabs of the predominant color blend in the roof covering being sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof. This claim limitation, among others, is reflected in the commercial embodiment of the invention and directly resulted in the success of the shingle product of the claimed invention in the residential shingle market.

Additionally, the use of slate material in the United States as a protective covering for roofs is documented for centuries. Archeological excavations at Jamestown, Virginia, have unearthed roofing slate in strata dating from 1625-1650 and 1640-1670. Slate roofs were introduced in Boston as early as 1654 and Philadelphia in 1699. Seventeenth century building ordinances of New York and Boston recommended the use of slate or tile roofs to ensure fireproof construction. Likewise, asphaltic-based shingles have been used since the early 1900's. Yet, a shingle for optically simulating a slate roof, as claimed in the present invention, remained unsolved until Appellant's application was filed in February, 2000. Appellant asserts the existence of this problem for a period of over 100 years, despite continued efforts of skilled artisans and refinements in the art, is evidence that the claimed roof covering was not obvious.

Finally, Mr. Elliott attested that the claimed shingle product sustained a significant premium price in the residential shingle market which could not be attributed to other features such as an improved warranty. Mr. Elliott provided evidence of competitors copying the shingle product of the claimed invention. Mr. Elliott referred to a competitor, CertainTeed Corp., who developed and released similar simulated slate roof shingles to the residential shingle market as early as June, 2004, which was only several months after the introduction of Appellant's shingle product onto the market. The secondary consideration evidence provided by Mr. Elliott provides additional and unquestionable support as to the non-obviousness of the shingle product of the present invention.

In conclusion, with respect to the contention that it would have been obvious to combine the Phillips and Overbury references to achieve a desired artistic effect, for the reasons stated above, the roof covering of the combined Phillips and Overbury references does not provide a roof covering wherein one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs to the extent that a predominant tab color blend is defined, with the other color blends being accent colors that occur less frequently in the roof covering, and with the predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof. Appellant's conclusion is supported by the declarations of Mr. Elliott and Mr. Vermilion.

Accordingly, claims 67 and 68 are non-obvious under 35 USC § §103(a) over Phillips in view of Overbury and Appellant respectfully requests reversal of the Examiner as to the rejection of claims 67 and 68.

B. Rejection of claims 17, 46-48, 53-58, 65-68 and 70 under 35 U.S.C. 103(a) over Hulett in view of Overbury.

The Examiner argued, on page 5 of the Final Office Action dated September 19, 2007, that it would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Hulett could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect.

The Hulett reference discloses laminated shingles having overlay members provided with a plurality of generally rectangular tabs separated by cutouts and underlay members provided with darker granules for a more pleasing appearance. The cutouts are illustrated as being narrow when compared to the tabs. The overlay has spaced apart tabs coated with a layer of colored granules. However, as noted by the Examiner on page 5, the Hulett reference fails to disclose the limitation that one of the color blends of the tabs occurs more frequently than any of the other color blends of

the tabs to the extent that a predominant tab color blend is defined, with the other color blends being accent colors that occur less frequently in the roof covering, and with the predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof.

For the same reasons as stated above, the Overbury reference fails to supply the missing limitation of a predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof.

With respect to the contention that it would have been obvious to combine the Hulett and Overbury references to achieve a desired artistic effect, the roof covering of the combined Hulett and Overbury references does not provide a roof covering wherein one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs to the extent that a predominant tab color blend is defined, with the other color blends being accent colors that occur less frequently in the roof covering, and with the predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof.

Accordingly, claims 17, 46-48, 53-58, 65-68 and 70 are non-obvious under 35 USC § §103(a) over Hulett in view of Overbury and Appellant respectfully requests reversal of the Examiner as to the rejection of claims 17, 46-48, 53-58, 65-68 and 70.

C. Rejection of claims 17, 46-48, 53-58, 65-68 and 70 under 35 U.S.C. 103(a) over Bondec in view of Overbury.

The Examiner argued, on page 7 of the Final Office Action dated September 19, 2007, that it would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Bondec could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect.

As discussed at page 3, at line 3 of Appellant's response dated July 20, 2001, the Bondec reference discloses a tri-laminated shingle having two overlays. Each

overlay has 3 tabs. The overlays have different colors and the tabs of the overlays are offset with respect to each other. When the two overlays are combined, alternating tabs have alternating colors. However, as noted by the Examiner on page 6 of the Final Office Action dated September 19, 2007, the Hulett reference fails to disclose the limitation that one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs to the extent that a predominant tab color blend is defined, with the other color blends being accent colors that occur less frequently in the roof covering, and with the predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof. The Examiner also noted on page 6 that the Bondec reference fails to specify grey as the predominant color. Additionally, as discussed in the last paragraph on page 9 of Appellant's response dated July 27, 2006, Bondoc discloses a roof covering that by its own terms disclaims the appearance of a slate roof (Column 1, lines 10-14). Bondoc clearly intends to portray a "unique shingle" that does not mimic tile, slate or wood shake roofs.

For the same reasons as stated above, the Overbury reference fails to supply the missing limitation of a predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof.

With respect to the contention that it would have been obvious to combine the Bondec and Overbury references to achieve a desired artistic effect, the roof covering of the combined Bondec and Overbury references does not provide a roof covering wherein one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs to the extent that a predominant tab color blend is defined, with the other color blends being accent colors that occur less frequently in the roof covering, and with the predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof.

Accordingly, claims 17, 46-48, 53-58, 65-68 and 70 are non-obvious under 35

USC § §103(a) over Bondec in view of Overbury and Appellant respectfully requests reversal of the Examiner as to the rejection of claims 17, 46-48, 53-58, 65-68 and 70.

### VIII. Claims Appendix

17. A roof covering including a plurality of successive generally horizontal courses of laminated shingles, the shingles in each course being laid in a side-by-side relationship and horizontally offset from the shingles in adjacent courses, each laminated shingle comprising:

an overlay member having front and rear surfaces, the overlay member including a headlap portion and a butt portion, the butt portion including a plurality of tabs separated by cutouts, each tab including a layer of granules on the front surface forming a generally uniform color blend, and each cutout being narrow when compared to the width of the tabs to provide an overall roof covering appearance of a natural slate roof; and

an underlay member having a front surface attached to the rear surface of the overlay member;

wherein each tab has a single color blend, the color blends of some of the tabs of each shingle being a color blend different from the color blend of others of the tabs; and

wherein one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs, thereby defining a predominant tab color blend, with the frequency of the tabs of the predominant color blend in the roof covering being sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof.

46. The roof covering according to Claim 17, wherein the predominant tab color blend occurs in roughly 60 percent of the tabs.

47. The roof covering according to Claim 46, wherein each laminated shingle has at least four tabs.

48. The roof covering according to Claim 46, wherein each laminated shingle is a three-tab laminated shingle.

53. The roof covering according to Claim 17, wherein each laminated shingle has at least four tabs.

54. The roof covering according to Claim 17, wherein each laminated shingle is a three-tab laminated shingle.

55. A roof covering including a plurality of successive generally horizontal courses of laminated shingles, the shingles in each course being laid in a side-by-side relationship and horizontally offset from the shingles in adjacent courses, each laminated shingle comprising:

an overlay member having front and rear surfaces, the overlay member including a headlap portion and a butt portion, the butt portion including a plurality of tabs separated by cutouts, each tab including a layer of granules on the front surface forming a generally uniform color blend, and each cutout being narrow when compared to the width of the tabs to provide an overall roof covering appearance of a natural slate roof; and

an underlay member having a front surface attached to the rear surface of the overlay member;

wherein each tab has a single color blend, the color blends of some of the tabs of each shingle being a color blend different from the color blend of others of the tabs; and

wherein one of the color blends of the tabs is gray, the gray color blend occurring more frequently than any of the other color blends of the tabs, thereby defining a predominant tab color blend, with the frequency of tabs of the gray color

blend in the roof covering being sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof.

56. The roof covering according to Claim 55, wherein the predominant tab color blend occurs in roughly 60 percent of the tabs.

57. The roof covering according to Claim 56, wherein each laminated shingle has at least four tabs.

58. The roof covering according to Claim 56, wherein each laminated shingle is a three-tab laminated shingle.

65. The roof covering according to Claim 17, wherein the cutouts have a width of about 1 inch and the tabs have a width of about 6 inches.

66. The roof covering according to Claim 55, wherein the cutouts have a width of about 1 inch and the tabs have a width of about 6 inches.

67. A roof covering including a plurality of successive generally horizontal courses of laminated shingles, the shingles in each course being laid in a side-by-side relationship and horizontally offset from the shingles in adjacent courses, each laminated shingle comprising:

an overlay member having front and rear surfaces, the overlay member including a headlap portion and a butt portion, the butt portion including a plurality of tabs separated by cutouts, each tab including a layer of granules on the front surface forming a generally uniform color blend; and

an underlay member having a front surface attached to the rear surface of the overlay member;

wherein each tab has a single color blend, the color blends of some of the tabs of each shingle being a color blend different from the color blend of others of the tabs; and

wherein one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs, thereby defining a predominant tab color blend, with the other color blends being accent colors that occur less frequently in the roof covering, with the frequency of tabs of the predominant color blend in the roof covering being sufficiently prevalent to provide a roof covering with an appearance that simulates a natural slate roof.

68. The roof covering according to Claim 67, wherein the predominant tab color blend occurs in roughly 60 percent of the tabs.

70. The roof covering according to Claim 67, wherein the cutouts have a width of about 1 inch and the tabs have a width of about 6 inches.

IX. Evidence Appendix

## A. Declaration of Bert W. Elliott entered January 24, 2005

The first Declaration of Bert W. Elliott was entered into the record on January 24, 2005, as noted on page 2 of the Office Action dated December 2, 2005. The Declaration includes Exhibits A (“Berkshire Collection” brochure) and B (“Centennial Slate” brochure).

## B. Declaration of Bert W. Elliott entered October 11, 2006

The second Declaration of Bert W. Elliott was entered into the record on October 11, 2006, as noted on page 2 of the Office Action dated October 11, 2006. The Declaration includes Exhibits A (“Berkshire Collection” brochure), B (“Centennial Slate” brochure) and C (U.S. Patent No. 1,843,370 to Overbury).

## C. Declaration of Donn R. Vermilion entered September 19, 2007

The Declaration of Donn R. Vermilion was entered into the record on September 19, 2007, as noted on page 2 of the Office Action dated September 19, 2007. The Declaration includes Exhibit A (Figures 6 and 8 of U.S. Patent No. 1,843,370 to Overbury).

X. Related Decisions Appendix

NONE